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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,142	03/31/2000	JEAN MARTINEZ	427.034	1834

7590 03/30/2004

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EXAMINER

SAKELARIS, SALLY A

ART UNIT PAPER NUMBER

1634

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/486,142

Applicant(s)

MARTINEZ ET AL.

Examiner

Sally A Sakelaris

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 26-29.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*Jim Son*  
3/24/04

  
JEFFREY FREDMAN  
PRIMARY EXAMINER

Continuation of 2: NOTE: The proposed amendments will not be entered. Specifically, applicant should note that their amendment to claim 27 is improper. Applicant's alteration of the claim language without properly identifying their changes to claim 27 is misleading to the examiner. Claim 27 is void of any markings that reveal that the recitation of "hydrogen" is being newly added to the claim. It would appear as if the recitation of "hydrogen" was present in an earlier version of the claims and as such, had been examined previously. However, it appears to be presented for the first time in this after final amendment of 3/5/2004. In addition to the amendment not being entered because it is improper, the amendments also extensively modify the claims and as a result will not be entered. The present terminology wherein the term "suppressed" is replaced by the word "hydrogen" extensively changes the claim as suppression versus the addition of a hydrogen molecule(s) to the end of the oligonucleotide varies extensively the presently claimed oligo and invention. Therefore the recitation of "hydrogen" raises new issues that would require further consideration and search.

Continuation of 5: does NOT place the application in condition for allowance because: The applicant's amendment to claim 27 is improper. In addition, the applicant's traversal on the grounds that it is believed that the present terminology wherein the term "suppressed" is replaced by the word "hydrogen" "was intended by the original meaning of Y1 or Y5 as being suppressed" and "meant that they were not an amino acid but, rather, a hydrogen atom" and further that "this is the only possibility for the sequences to consist of 9 nucleotides" is not found to be convincing. The examiner does not understand this argument as it does not seem to be an inherent quality of an absent nucleotide that a single hydrogen atom is always present. Furthermore, the remaining rejections are also maintained for reasons of record in view of the non-entry of after final amendment.